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10/689,465	10/20/2003	Reuben Clark	033680-001	4146

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EXAMINER

GUSHI, ROSS N

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2833

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/689,465
Filing Date: October 20, 2003
Appellant(s): CLARK ET AL.

MAILED
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GROUP 2800

Kevin Lyn
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/31/06 appealing from the Office action mailed 4/7/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3988052	Mooney et al.	10-1976
4189198	Reichman	2/1980
4210374	Churla	7/1980

4806108	Meinhardt	2/1989
2116776	Bondeson	5/1938
4159859	Shemtov	7/1979
5816844	Perera	10/1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 11-13, 17, 18-22, 24, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mooney et al. ("Mooney") in view of Reichman, Churla, and Meinhardt.

Regarding claims 9, 11, and 12 Mooney discloses a clamping apparatus for electrically connecting at least a first ground wire to a grounding member, the clamping apparatus comprising: a bottom clamping member 14 comprising a bottom medial portion and a threaded hole on both sides of the bottom medial portion; a top clamping member 13 cooperating with the bottom clamping member and comprising a top medial portion aligned to cooperate with the bottom medial portion and corresponding holes on

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either side of a top medial portion that correspond to, and are slightly larger in diameter than, the threaded holes to allow a screw (16, 17) to pass through each hole in the top clamping member and thread into the corresponding threaded hole in the bottom clamping member, thereby providing a clamping action around the ground member between the top and bottom clamping members when the screws are tightened, and an integral fixed trough 15 including a set screw passing toward conduit 12 to hold cable 11 parallel to the conduit.

Mooney does not disclose that the wire is pressed against the sidewall and the set screw axis intersects the first screw axis.

Reichman discloses a trough comprising a base wall 23 and a first and second side walls (26, 27), where the set screw passes from a side wall of the trough to hold the cable parallel to the conduit. Meinhardt discloses a trough where the set screw passed downward toward the conduit to hold the cable crosswise to the conduit. Churla discloses a trough including set screw passing through a sidewall of the trough to hold the cable crosswise to the conduit. At the time of the invention, it would have been obvious to configure the integral Mooney trough and set screw as desired regarding whether the screw is directed from a top wall or sidewall and regarding whether the cable is directed parallel to the conduit or perpendicular to the conduit, as taught in Reichman, Meinhardt, Mooney, and Churla. Such variations in the configurations of the trough and set screw would have been a matter of engineering design choice, being a rearrangement of parts without patentable significance. See In re In re Harza, 124 USPQ 378 (CCPA 1960), In re Japikse, 86 USPQ 70 (CCPA 1960).

Per claim 13, one or both of the top and bottom medial portions are crowned in a direction away from the respective other medial portion to create an opening between the top and bottom clamping members for accommodating the grounding member.

Per claim 17, the Mooney/Reichman trough is capable of accommodating an additional second ground wire laid-in along side the first ground wire in the trough, said first and second ground wires being mechanically and electrically connected by the clamping pressure of set screw.

Claims 18-22, 24, 26, and 27 are rejected for the reasons pertaining to claims 9, 11-13, 17.

Claims 14 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mooney, Reichman, Meinhardt, and Churla as in claims 13 and 18 in view of Bondeson. Mooney does not show serrations. Bondeson discloses serrations 17. At the time of the invention, it would have been obvious to include serrations on the Mooney clamps as taught in Bondeson. The suggestion or motivation for doing so would have been to improve the grip of the clamp on the grounding conduit as taught in Bondeson.

Claims 16 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mooney, Reichman, Meinhardt, and Churla as in claims 9 and 18 in view of Shemtov. Reichman arguably does not use a wedge. Shemtov discloses wedge 33. At the time of the invention, it would have been obvious to include a wedge on the Reichman screw as taught in Shemtov. The suggestion or motivation for doing so would have been to better secure the ground wire as taught in Shemtov.

Claims 15 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mooney, Reichman, Meinhardt, and Churla as in claims 13 and 18 in view of Perera. Reichman does not use a rounded screw end. Perera discloses a set screw with a rounded end 34. At the time of the invention, it would have been obvious to modify the Reichman screw end to optimize the contact between the wire and the clamping device, such as by using a rounded screw end as taught in Perera. For example the Perera screw end is useful for use on insulated wire to pierce the insulation on the wire.

(10) Response to Argument

At Brief page 12 Section A, as best understood by the examiner, the applicant is arguing that somehow the examiner is not considering the invention "as a whole." Brief page 12, section A. The examiner maintains that the claimed invention has been considered as a whole. As a whole, the claimed invention would have been obvious in view of the disclosures of the prior art of record. The "focus of the Office" is not solely on the configuration of the trough as argued by the Applicant. Each and every claimed limitation is given full weight; no claim limitation is ignored or given little weight.

Applicant seems to be arguing that none of the prior art references disclose each and every limitation so as to satisfy a 35 USC 102(b) rejection. Brief pages 13-20. The examiner has not indicated that the rejection is under 35 USC 102(b) however. The examiner has not indicated that each prior art reference teaches every claimed limitation, which applicant seems to be arguing is necessary for a finding of

obviousness. Brief pages 13-20. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

At Brief page 20 Section B, Applicant argues that “Neither *In re Harza* nor *In re Japikse* provides the teaching, suggestion, or motivation to combine the cited references set forth in the 35 U.S.C. 103 rejections.” The examiner maintains that it would have been obvious to configure the integral Mooney trough and set screw as desired regarding whether the screw is directed from a top wall or sidewall and regarding whether the cable is directed parallel to the conduit or perpendicular to the conduit and that such variations in the configurations of the trough and set screw would have been a matter of engineering design choice, being a rearrangement of parts without patentable significance. See *In re In re Harza*, 124 USPQ 378 (CCPA 1960), *In re Japikse*, 86 USPQ 70 (CCPA 1960). There is no evidence in the specification or in Applicant’s arguments that applicant’s claimed orientation of the set screw and trough has any significance or advantage compared to the orientations of the set screws and troughs of the prior art. There is nothing in Applicant’s specification indicating whether or why the particular orientation of the applicant’s configuration of set screw and trough is important to the invention. Similarly, the prior art (Mooney, Reichman, Meinhardt, and Churla) discloses set screws and troughs oriented in a variety of configurations, including applicant’s claimed configuration, and does not indicate that any particular orientation is particularly advantageous or disadvantageous. It would have been

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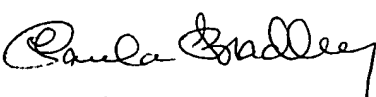
obvious that well known engineering design considerations, such as which direction of approach to the screw would the user be likely to use, would be a factor in choosing whether the set screw should approach from the top of the clamp or from the side of the clamp. Modifying the Mooney clamp such that the set screw approaches from the side rather than the top would not change the operation of the Mooney clamp or provide any kind of new result.

Regarding *In re Japikse*, 86 USPQ 70 (CCPA 1960), the Applicant points out an irrelevant portion of that opinion to argue that *Japikse* is irrelevant. The relevant portion of *Japikse* is that regarding *Japikse* claim 3, the Court held that there would be “no invention” in moving the starting switch on a hydraulic press to a different position since the operation of the press would not be modified. 86 USPQ at 73. The same applies to the invention here, moving the direction of approach of the set screw from the top to the side does not change the operation of the device. Similarly, *In re Harza*, 124 USPQ 378 (CCPA 1960) holds that a duplication of parts is not significant where there are no new and unexpected results. Considered together, the opinions indicate that a minor rearrangements of parts, such as the moving the direction of approach of the set screw from the top of the clamp to the side the clamp, where the operation of the clamp is not affected, and there are no unexpected results, would have been a matter of engineering design choice.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

Paula Bradley 

Darren Schuberg 

Ross Gushi

ROSS GUSHI
PRIMARY EXAMINER

